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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,764	11/25/2003	Masashi Yonemaru	829-618	3114

23117 7590 02/16/2007
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

DICKEY, THOMAS L

ART UNIT	PAPER NUMBER
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2826

MAIL DATE	DELIVERY MODE
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02/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/720,764	Applicant(s) YONEMARU, MASASHI	
	Examiner Thomas L. Dickey	Art Unit 2826	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

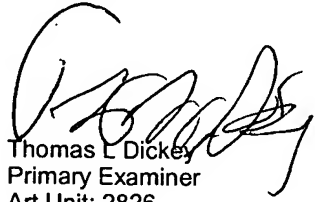
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1, 6 and 8.
 Claim(s) withdrawn from consideration: 2, 3, 5, 7 and 9-23.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 Thomas L. Dickey
 Primary Examiner
 Art Unit: 2826

Continuation of 11. does NOT place the application in condition for allowance because: The issue is whether claim 1 may prohibit indirect connection a) between the first and second PMOS transistors; and b) between the first and second NMOS transistors, or whether claiming such a prohibition would constitute new matter.

Applicant and Examiner agree that there is nothing in the written (specification, abstract, title, and claims as originally filed) portion of the application as filed that shows Applicant in possession of an invention including this prohibition.

Applicant contends, however, that certain figures of the application (e.g., Figs. 2B, 5B, 10B, 13B-15B) show direct connections between the first and second NMOS transistors as well as direct connections between the first and second PMOS transistors. Applicant argues further on this point but the Examiner is unable to follow Applicant's reasoning. Why should a drawing of one embodiment of an invention be construed as an indication that all alternate embodiments are prohibited? See, e.g., *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc) (holding that a patent whose drawings showed only angled steel baffles should not be construed to prohibit the claims from covering a structure whose "steel baffles" were perpendicular to its walls).

It is argued, at page 2 of the remarks, that "There is no requirement that a feature shown in the drawings also be described in text - this would be virtually impossible in many instances." The Examiner is not concerned with hypothetical cases. In this particular case it would have been utterly possible for this particular Applicant to have described the newly claimed feature in text - all one would have needed to write would have been, "indirect connection between the transistors is prohibited in this invention." Ten words, most of them being two syllables or less, would have done the trick.

Applicant also implies that Figs. 2B, 5B, 10B, 13B-15B are the clearest possible graphical depiction of the prohibition on indirect connection Applicant now wishes to claim. Again, the Examiner disagrees. All civilized beings are by now familiar with the use of a diagonal slash embedded in a circle to make a graphical depiction of "prohibited." The circle/slash appears over cigarettes to prohibit smoking, over skateboards to prohibit skateboarding, over cell-phones to prohibit phoning. It has been used to indicate the prohibition of a host of other activities. Had Applicant contemplated prohibiting indirect connections between the transistors of Applicant's invention, Applicant could have done the same by placing the circle/slash over a drawing of an indirect connection. .